REMARKS

Claims 1-30 are pending and are unamended. Withdrawal of all objections and rejections are respectfully requested for at least the reasons set forth below.

Request for Interview Prior to Formal Action on Amendment

Applicants request an interview prior to formal action on this amendment. An "Applicant Initiated Interview Request Form" accompanies this paper. Please contact Applicants' undersigned representative to schedule the interview.

Prior Art Rejections

1. Claims 1 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Montulli in view of Hsu.

2. Claims 1, 3, 6, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reha et al. in view of Hsu.

3. Claims 2, 8-15, 17 and 20-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reha et al. and Hsu in view of McCormick et al.

4. Claims 4 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reha et al. and Hsu and further in view of Horvitz.

5. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Reha et al. and Hsu and further in view of Montulli.

1. Montulli

Page 3, line 3 of the outstanding Office Action states that column 4, lines 38-42 of Montulli discloses downloading a "file" to the client machine. As discussed in previous responses, Montulli is a well-known patent that is touted as describing the original concept of a cookie. Montulli describes the purpose of a cookie, how cookies are sent, and what they do on a client machine. Montulli thus describes downloading a cookie file to a client machine. At the client machine, a list of cookie files is stored.

Page 3, lines 4-5 of the outstanding Office Action further states that column 9, lines 52-62 of Montulli discloses using the downloaded list to detect files received at the client machine from sources on the downloaded list. This is incorrect. Neither this portion nor any other portion of Montulli describes downloading a list of cookie files, or any list at all. Montulli clearly describes downloading only individual cookies (not a list of cookies), and then building a list of cookies at the local computer. See, for example, column 8, lines 1-5 of Montulli. Column 9, lines 52-62 of Montulli referred to by the Examiner merely describes the process for using the previously built list of cookies to decide whether to send an http request to a web server, thereby using the cookies for their intended purpose.

In sum, Montulli creates a list of cookies at the client machine from cookies individually downloaded from web servers, but does not describe downloading a list of cookies.

Montulli thus does not disclose or suggest any of the three steps in claims 1 and 16, each of which require a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine. Montulli also does not disclose or suggest at least step (c) of claims 7 and 22 and step (a) of claims 12 and 27, both of which require receiving at a client machine, from a service provider, a master list of cookie file sources.

2. Hsu

Page 3, lines 7-8 of the outstanding Office Action states that paragraphs [0058] and [0059] of Hsu disclose a list of cookie file sources at the server. This appears to be correct. Hsu's secure server is used to protect a client machine from harmful effects of cookies. To do so, the secure server stores a list of cookie files sources and uses that list to decide whether or not to pass information between a client machine and web server. However, nowhere does Hsu disclose or suggest that the list of cookie files sources be downloaded to the client machine.

In fact, Hsu teaches away from this feature since the purpose of Hsu is to use the list of cookie file sources at the proxy server, not at the client machine. A user at the client machine controls the content of the cookie file source list stored at the secure server, described in paragraph [0057]. However, even if it could be argued that the user sends a list of cookie file sources to the secure server (and there is not even any clear disclosure of this feature), Hsu's data flow is from the client machine to the secure server, not from the secure server to the client

machine. Hsu's data flow is completely opposite to the downloading direction of the list set forth in the claims, which is from a server or service provider to a client machine. Furthermore, paragraph [0058] even states that in the described embodiment, "cookies are never actually transferred to the terminal 16." If the cookies are never transferred, then a list of cookies inherently cannot be transferred.

To summarize, even though Hsu maintains a list of cookie file sources. Hsu also fails to disclose or suggest any of the three steps in claims 1 and 16, each of which require a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine. Hsu also does not disclose or suggest at least step (c) of claims 7 and 22 and step (a) of claims 12 and 27, both of which require receiving at a client machine, from a service provider, a master list of cookie file sources. Hsu thus suffers from the same deficiencies as highlighted above in Montulli.

Furthermore, the individual, user-driven cookie control processes described in Hsu and Montulli both suffer from one of the prior art deficiencies highlighted in the background of the present application, which reads as follows:

> There are software programs that let users create a profile of which types of cookie files they will accept. However, there is no guarantee that cookie files generated by companies with a history of abusing the use of cookie files will be screened out, nor is there a universal reference source for determining which cookie file sources should not be accepted. What is needed is a professional service that constantly researches and evaluates cookie file sources (e.g., websites), cookie files, consumer complaints and other statistical data, and develops and electronically distributes to subscribing computer users, on a periodic basis, a list of those cookie file sources that the service recommends should not be permitted to store cookie files in the subscribing user's computer. What is also needed is a user-friendly interface for enabling a user to easily and automatically modify the distributed list once it is received by the user's computer, such that the user may customize the list to meet his or her individual or organizational requirements. (page 2, lines 19-30 of the specification)

The present invention addresses this problem by maintaining a list of cookie file sources at a server or service provider and then downloading the list to client machines. In preferred

embodiments of the present invention, the list can be created from many sources, not just from one user's choice of which cookies should be accepted or rejected, such as described in Hsu.

3. Reha et al.

Page 4, lines 1-5 of the outstanding Office Action states that column 2, lines 1-8 of Reha et al. discloses requesting and downloading files from a server to a client machine. This is correct. Reha discloses downloading a file that contains a list of software components from a remote server to a PC. The outstanding Office Action further states that the downloaded list is used to detect files received at the client machine from sources on the downloaded list. This is incorrect. The file only contains a list of software components corresponding to a software program. The downloaded list is used as follows:

1. A software component is selected from the list in the downloaded file.
2. The software component is checked to determine whether it is stored on the PC.
3. Based on the results of the checking, the software program may be updated.

The downloaded list is not used to detect files received at the client machine from sources on the downloaded list. Instead, the downloaded list is used to determine whether or not to update the software program.

Notwithstanding the discrepancies highlighted above, neither the file, downloaded list, or software program have anything to do with a list of cookie file sources. Accordingly, the Examiner relies upon Hsu for this feature and asserts that Reha et al. could have been modified to download cookie file sources.

In response, as discussed above, Hsu does not disclose or suggest downloading a list of cookie file sources from a server or service provider to a client machine. Thus, even if Reha et al. is combined with Hsu, no such downloading would exist. Furthermore, such a combination is improper because it would destroy the intended purpose of Reha et al. since a list of cookie file sources would not be able to function as an equivalent to the software components that need to be checked in Reha et al. to determine if the software program needs to be updated. In fact, downloading a list of cookie files sources and/or using the list does not require updating software programs, which is the purpose of the invention in Reha et al.

4. McCormick et al.

The system in McCormick et al. filters unwanted junk email sent to a user's computer by using a "No Admittance List." McCormick et al. has nothing to do with cookie files sources, and thus does not make up for any of the above-noted deficiencies in the other applied references.

5. Patentability of independent claims over all applied combinations

Even if the applied references were combined and modified as proposed by the Examiner, the resultant systems would still fail to disclose or suggest at least the following claim limitations:

Claims 1 and 16: a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine.

Claims 7 and 22, step (c); and claims 12 and 27, step (a): receiving at a client machine, from a service provider, a master list of cookie file sources.

6. Patentability of dependent claims

The dependent claims are believed to be allowable because they depend upon respective allowable independent claims, and because they recite additional patentable steps.

7. Hsu's priority date is insufficient to support a prima facie rejection

All of the grounds of the outstanding rejection include Hsu. Hsu has a filing date of February 22, 2001 which is prior to the March 28, 2001 filing date of the present application. However, the present application claims priority from Provisional Application No. 60/264,382 filed January 26, 2001 which is prior to the Hsu's filing date. Appendix A is a copy of Applicants' provisional application. The present set of claims is fully supported by the Applicants' provisional application. See, for example, that all of the figures in the Applicants' provisional application are similar to the figures in the present non-provisional application. Accordingly, Applicants are entitled to the priority date of the provisional application for the presently claimed invention.

Hsu also claims priority to an earlier application, namely U.S. Patent Application No. 09/580,365, hereafter, "Hsu's priority application." Appendix B is a copy of Hsu's priority

application. Appendix C is a text comparison of Hsu to Hsu's priority application. The comparison shows that key portions of Hsu relied upon by the Examiner, particularly, paragraphs [0062] and [0063] did not exist in Hsu's priority application. Accordingly, Hsu is not entitled to an earlier priority date for the disclosures in Hsu relied upon by the Examiner in the outstanding rejections. Therefore, Applicants' patent application has an earlier priority date than Hsu and thus all of the outstanding rejections which are based upon Hsu must be withdrawn.

Appendix D is a time line showing the relevant filing dates of the four patent applications discussed above.

Conclusion

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. Issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

ADAM R. SCHRAN et al.

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(Date)

CLARK A. JABLON
Registration No. 35,039
AKIN GUMP STRAUSS HAUER & FELD LLP
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, PA 19103-7013
Telephone: 215-965-1200
Direct Dial: 215-965-1293
Facsimile: 215-965-1210
E-Mail: cjablon@akingump.com

Enclosure (Appendices A-D)